

REMARKS**I. General**

Claims 1-77 were pending in the application, and all of such claims were rejected in the Office Action mailed July 3, 2003. The outstanding issues in the present Office Action are:

- Claims 1-20, 22-70, and 72-77 are rejected under 35 U.S.C. § 102(e) as being anticipated by Published U.S. Patent Application Number 2002/0055866 A1 of Dewar (hereinafter "*Dewar*"); and
- Claims 21 and 71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dewar* in view of U.S. Patent Number 6,064,977 issued to Haverstock et al. (hereinafter "*Haverstock*").

In response, Applicant respectfully traverses the outstanding claim rejections, and requests reconsideration and withdrawal thereof in light of the remarks presented herein.

II. Claim Rejections Under 35 U.S.C. § 102(e) over *Dewar*

Claims 1-20, 22-70, and 72-77 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Dewar*. Applicant respectfully traverses this rejection as provided further below.

A. Many Relied Upon Portions of *Dewar* are not Prior Art Under § 102(e)

The present application has a filing date of August 17, 2000. *Dewar* is a published U.S. patent application having a filing date of June 12, 2001, and claims the benefit of a provisional patent application having a filing date of June 12, 2000. The Examiner uses the date of the provisional patent application as the § 102(e) date of *Dewar*, which seems consistent with the *Examination Guidelines for 35 U.S.C. § 102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. § 102(g) (see e.g., Section IV "Examination Procedures under 35 U.S.C. §§ 102(e) and 374" thereof).*

However, Applicant respectfully submits that only the subject matter that was actually present in the provisional patent application (referred to hereafter as “*Dewar Provisional*”) is afforded the earlier date of June 12, 2000. For instance, the published U.S. patent application of *Dewar* having a filing date of June 12, 2001 includes matter that was not present in *Dewar Provisional*, and such new matter is not afforded the benefit of the filing date of the provisional patent application. M.P.E.P. § 201.11 explains that there are six conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e). The first requirement is that the “second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112.” M.P.E.P. § 201.11, citing *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994).

Because a copy of the *Dewar Provisional* application was not provided with the present Office Action, Applicant’s attorney, Jody Bishop, called the Examiner and requested a copy of such provisional application, which the Examiner provided to Applicant’s attorney via fax on September 15, 2003. Some portions of the published U.S. patent application (“*Dewar*”) relied upon by the Examiner in the present Office Action do not appear in the provisional application (“*Dewar Provisional*”). For instance, in item 4 on page 3 of the present Office Action, the Examiner cites to various portions of *Dewar*, including the Abstract, Figs. 1-13, para 0015-0100, para 0111-0113, and claim 1. *Dewar Provisional* does not include all of these portions that are relied upon by the Examiner. For instance, *Dewar Provisional* does not include the Abstract of *Dewar*. Also, Fig. 1 of *Dewar* includes additional elements that are not shown in Fig. 1 of *Dewar Provisional*. Further, Figs. 2-9 of *Dewar* are not included in *Dewar Provisional*. Further, all of paragraphs 0015-0100 and 0111-0113 of *Dewar* are not found in *Dewar Provisional*. As an example, at least paragraphs 0015-0025 of *Dewar* are not found in *Dewar Provisional*. Further, claim 1 of *Dewar* is not included in *Dewar Provisional*.

Thus, many of the relied upon portions of *Dewar* are not actually prior art under 35 U.S.C. § 102(e) because such relied upon teachings of *Dewar* are not actually present in *Dewar Provisional* but are instead newly added matter included in the published U.S. patent

application (and therefore should not be afforded the benefit of the provisional application's filing date).

Because the disclosure of *Dewar* is not identical to that of *Dewar Provisional* (but instead includes additional matter not included in *Dewar Provisional*, as discussed above) and because only those portions of *Dewar* that are present in *Dewar Provisional* are eligible as prior art to the present application under 35 U.S.C. § 102(e), Applicant requests that if the Examiner maintains the present rejection of any of the claims in a future Office Action, the Examiner specifically identify the portions of *Dewar Provisional* upon which the Examiner relies in making such rejection. Otherwise, if the subject matter relied upon in rejecting a given claim cannot be found in *Dewar Provisional*, the rejection of such claim under 35 U.S.C. § 102(e) should be withdrawn. As discussed further below, Applicant submits that *Dewar Provisional* fails to teach all of the elements of the claims of the present application.

B. *Dewar Provisional* Fails to Teach All Elements of the Claims

As discussed in section "A" above, only those portions of *Dewar* that are present in *Dewar Provisional* are eligible as prior art to the present application under 35 U.S.C. § 102(e). For *Dewar* to anticipate the claims of the present application, *Dewar Provisional* must anticipate those claims. Applicant does not concede that *Dewar Provisional* is prior art to Applicant's claimed invention, but reserves the right to overcome this rejection by antedating the filing date of *Dewar Provisional* by submitting a declaration in accordance with 37 C.F.R. § 1.131. In any case, as discussed further below, *Dewar Provisional* fails to anticipate the claims of the present application, and thus the rejection of those claims under 35 U.S.C. § 102(e) over *Dewar* should be withdrawn.

To anticipate a claim under 35 U.S.C. § 102, a single reference must teach every element of the claim, *see* M.P.E.P. § 2131. As discussed further below, *Dewar Provisional* does not teach every element of the rejected claims, and therefore *Dewar Provisional*, and in turn *Dewar*, fails to anticipate such claims under § 102(e).

i. Independent Claims

For example, independent claim 1 recites, *inter alia*, "based on said desired hiring criteria of said employer, said computer program generating at least one customized

application program that is executable to interact with candidates for employment with said employer” (emphasis added).

Independent claim 30 recites, *inter alia*, “a computer program executable by said processor-based device to receive as input desired hiring criteria of said employer and generate at least one application program, said at least one application program executable to interact with candidates” (emphasis added).

Independent claim 54 recites, *inter alia*, “code for presenting a user interface for receiving hiring criteria from an employer; and code for generating at least one qualification program for interacting with candidates” (emphasis added).

Independent claim 62 recites, *inter alia*, a business method comprising “allowing an employer access to a computer executable program, wherein said computer executable program enables said employer to generate at least one customized application program based on a desired hiring criteria of said employer; and allowing candidates access to the at least one generated customized application program” (emphasis added).

Dewar Provisional fails to teach or suggest at least the above limitations of independent claims 1, 30, 54, and 62. *Dewar Provisional* teaches a technique for predicting the job performance of candidates based on a Customer Service/Clerical Potential Index (CS/CPI) determined for the candidates. *See e.g.*, “Background” at page 1 and “Specification” at page 6 of *Dewar Provisional*. The CS/CPI is used to predict both performance and turnover potential for customer service and clerical occupations. *See e.g.*, “Background” at page 1 of *Dewar Provisional*. In general, *Dewar Provisional* teaches that an extensive study was conducted in which job applicants for customer service and clerical positions completed a questionnaire of autobiographical questions. Thereafter, the performance and turnover rate of those job applicants was monitored. From this, a statistical relationship between answers to the autobiographical questions and job performance/turnover rate were determined. Accordingly, *Dewar Provisional* teaches that, once determined, such statistical relationship (e.g., the CS/CPI) may be used for predicting the likely performance of a candidate based on his/her answers to the autobiographical questions.

Dewar Provisional primarily discusses the study that was conducted for developing and analyzing the CS/CPI, the CS/CPI's compliance with equal employment, civil rights, and Americans with disabilities considerations, and specific autobiographical questions that may be presented to a candidate for employment. The specific autobiographical questions that are used in *Dewar Provisional* are categorized into four separate categories: 1) Application Questions, 2) Customer Service, 3) Working with Information, and 4) Sales Potential Inventory. See e.g., the table on pages 7-8 and the table on page 9 of *Dewar Provisional*. Specific Application Questions that are used are described on pages 9-12; specific Customer Service questions are described on pages 12-21; specific Working with Information questions are described on pages 22-30; and specific Sales Potential Inventory questions are described on pages 31-32 of *Dewar Provisional*.

Dewar Provisional fails to provide any discussion of how an application that might present the autobiographical questions to a candidate is generated. Indeed, the only reference in *Dewar Provisional* to the actions that may be performed by a client (employer) in setting up the described solution for questioning candidates and predicting their likely performance/turnover (referred to as the ePredix Solution) is provided in Fig. 4, which is a flow diagram that is not described (or even mentioned) in the text of *Dewar Provisional*. From the flow diagram of Fig. 4, it appears that a client may go to the ePredix website and log on as a client (box 1 of Fig. 4). Then, it appears that a client may perform one of three tasks on the ePredix website: 1) Set up an ePredix Solution, 2) View Applicant Results, or 3) Set up Applicants for a Selection Solution. If the client decides to set up an ePredix Solution, it appears from box 2 of Fig. 4 that the client may input the details of the job for which they wish to create an ePredix solution. Then, in box 3 of Fig. 4, the client may select from a series of drop down menus the categories that best describe their job. In box 4 of Fig. 4, the client is presented with the option of selecting different components of an ePredix solution (all of which are suitable for the type of job they have). In box 5 of Fig. 4, the client selects components to create an ePredix solution suitable for their job. In box 6 of Fig. 4, the client is provided with a URL and are instructed to add the URL to their online job advertisement. In box 7 of Fig. 4, the client attaches the URL to an online advertisement and awaits applicants to apply.

Dewar Provisional fails to teach a “computer program generating at least one customized application program that is executable to interact with candidates for employment with said employer”; as recited by claim 1, for example. For instance, the flow diagram of Fig. 4 of *Dewar Provisional* fails to teach that a computer program generates a customized application program for interacting with candidates for employment. As described above, Fig. 4 shows that a client inputs the details of the job for which they wish to create an ePredix solution (box 2). Further, the client selects from a series of drop down menus categories that best describe the job (box 3). And, the client selects components to create an ePredix solution suitable for their job (boxes 4 and 5). Fig. 4 fails to show that a computer program generates a customized application, however. Rather, a programmer, for instance, may presumably receive the input from the client and develop a computer program that satisfies the client’s desires, rather than a computer program generating such customized application. Thus, *Dewar Provisional* fails to teach at least the above identified elements of independent claims 1, 30, 54, and 62, and therefore *Dewar Provisional*, and in turn *Dewar*, fails to anticipate those independent claims under § 102(e).

ii. Dependent Claims

Further, dependent claims 2-20, 22-29, 31-53, 55-61, 63-70, and 72-77 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Dewar*. In view of the above, Applicant respectfully submits that independent claims 1, 30, 54, and 62 are not anticipated under 35 U.S.C. § 102(e) by *Dewar* because *Dewar Provisional* fails to teach each and every element of such independent claims. Further, each of dependent claims 2-20, 22-29, 31-53, 55-61, 63-70, and 72-77 depend either directly or indirectly from one of independent claims 1, 30, 54 and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 2-20, 22-29, 31-53, 55-61, 63-70, and 72-77 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

For example, dependent claim 2 recites “wherein said desired hiring criteria includes at least one criteria selected from the group consisting of: candidate’s education, candidate’s work experience, candidate’s possessing a particular license, candidate’s language skills, and

candidate's computer skills." *Dewar Provisional* fails to teach a computer program receiving as input from an employer such desired hiring criteria as those recited in claim 2. As mentioned above, box 5 of Fig. 4 of *Dewar Provisional* provides that the client selects "components" to create an ePredix solution suitable for their job. What is meant by the term "components" as used in Fig. 4 is not mentioned or described anywhere in the *Dewar Provisional* application. As mentioned above, *Dewar Provisional* does describe that 4 separate categories of questions may be used in screening a candidate: 1) Application Questions, 2) Customer Service, 3) Working with Information, and 4) Sales Potential Inventory. Assuming that each of those categories is a "component" (without conceding that point), this does not teach the employer inputting any of the types of hiring criteria identified in claim 2. Rather, the questions associated with each of the categories in *Dewar Provisional* appear to be pre-defined questions developed through the extensive study as being able to predict candidate's performance/turnover likelihood, and thus the employer does not input the types of hiring criteria as those identified in claim 2. Accordingly, claim 2 is not anticipated by *Dewar Provisional*, and, in turn, is not anticipated by *Dewar*.

As another example, claim 4 recites "wherein said computer program allows said employer to input additional hiring criteria not included on said predetermined list." This element is not taught by *Dewar Provisional*. To the extent that Fig. 4 of *Dewar Provisional* teaches an employer inputting a hiring criteria at all, it certainly does not teach allowing the employer to input additional hiring criteria that is not included on a predetermined list. For instance, the employer is allowed to select "components," but *Dewar Provisional* does not teach that the employer may input additional hiring criteria that is not available for selection on a predetermined list. Accordingly, claim 4 is not anticipated by *Dewar Provisional*, and, in turn, is not anticipated by *Dewar*.

As another example, claim 16 recites "wherein said computer program receives as input from said employer indication of one or more communication platforms on which said at least one customized application program is to enable access by candidates." *Dewar Provisional* fails to teach this element of claim 16. That is, *Dewar Provisional* fails to teach that an employer may input to a computer program an indication of one or more communication platforms on which a customized application program is to enable access by candidates. As mentioned above, Fig. 4 of *Dewar Provisional* appears to be the only mention

of the actions taken by the employer in setting up an ePredix Solution, and Fig. 4 fails to show this type of input from an employer. Accordingly, claim 16 is not anticipated by *Dewar Provisional*, and, in turn, is not anticipated by *Dewar*.

As another example, claim 22 recites “wherein said at least one customized application program is executable to forward supplemental materials to hiring personnel of the employer for a candidate determined based on said desired hiring criteria to be qualified for a position of employment with the employer.” *Dewar Provisional* fails to teach this element of claim 22. That is, *Dewar Provisional* fails to teach that an application program with is executable to forward supplemental materials to hiring personnel. While *Dewar Provisional* teaches various categories of autobiographical questions that may be presented to a candidate by an application program, it fails to teach such an application program forwarding supplemental materials to hiring personnel. Accordingly, claim 22 is not anticipated by *Dewar Provisional*, and, in turn, is not anticipated by *Dewar*.

As another example, claim 26 recites “said at least one customized application receiving said supplemental materials from a candidate.” *Dewar Provisional* fails to teach this element of claim 26. That is, *Dewar Provisional* fails to teach that an application program with is executable to receive supplemental materials from a candidate. While *Dewar Provisional* teaches various categories of autobiographical questions that may be presented to a candidate by an application program, it fails to teach such an application program receiving supplemental materials from a candidate. Accordingly, claim 26 is not anticipated by *Dewar Provisional*, and, in turn, is not anticipated by *Dewar*.

As another example, claim 27 recites “wherein said at least one customized application receives said supplemental materials via at least one of the following methods: fax, e-mail, and digital imaging device.” *Dewar Provisional* fails to teach this element of claim 27. As mentioned above with regard to claim 26, *Dewar Provisional* fails to teach that an application program with is executable to receive supplemental materials from a candidate. Thus, *Dewar Provisional* fails to teach that an application program is executable to receive supplemental materials via any of the methods identified in claim 27. Accordingly, claim 27 is not anticipated by *Dewar Provisional*, and, in turn, is not anticipated by *Dewar*.

As still another example, claim 41 recites “wherein said computer program is executable to generate a plurality of said application programs.” *Dewar Provisional* fails to teach this element of claim 41. As mentioned above with regard to independent claims 1, 30, 54, and 62, *Dewar Provisional* fails to teach a computer program executable to generate an application program. Thus, *Dewar Provisional* fails to teach a computer program that is executable to generate a plurality of such application programs, as recited by claim 41. Accordingly, claim 41 is not anticipated by *Dewar Provisional*, and, in turn, is not anticipated by *Dewar*.

As still another example, claim 42 recites “wherein each of said plurality of application programs is executable to enable interaction with candidates via a different communication platform.” *vDewar Provisional* simply fails to teach this element of claim 42. Accordingly, claim 42 is not anticipated by *Dewar Provisional*, and, in turn, is not anticipated by *Dewar*.

III. Claim Rejections Under 35 U.S.C. § 103(a) over *Dewar* in view of *Haverstock*

Dependent claims 21 and 71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dewar* in view of *Haverstock*. As discussed above, Applicant respectfully submits that independent claims 1, 30, 54, and 62 are of patentable merit over *Dewar*. Further, each of dependent claims 21 and 71 depend either directly or indirectly from one of independent claims 1 and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 21 and 71 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

IV. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 59428/P001US/10020580 from which the undersigned is authorized to draw.

Dated: October 3, 2003

Respectfully submitted,

By 

Jody C. Bishop

Registration No.: 44,034

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue, Suite 2800

Dallas, Texas 75201-2784

(214) 855-8007

(214) 855-8200 (Fax)

Attorney for Applicant